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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/996,825

**Applicant(s)**

SUNDEL, MICHAEL B.

**Examiner**

Narayanswamy Subramanian

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 23-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 23-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/7/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicant's communication filed on January 7, 2005. Amendments to claims 1-4, 6 and 9, cancellation of claims 12-22 and addition of new claims 23-52 have been entered. The rejection of claims 1-5 and 9 under 35 USC § 101 made in the last office action are withdrawn by the Examiner in view of the amendment. Claims 1-11 and 23-52 are currently pending in this application and have been examined. The objections, rejections and response to arguments are stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 32, 33 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 32 and 52 the phrase "one or more hardware and/or software devices" is vague and indefinite. In claims 1 and 33, it is not clear what the Applicant means by the phrase "for facilitating". The metes and bounds of this limitation are not clear. Clarification/correction is required.

#### ***Claim Objections***

4. Claims 31, 32 and 52 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. See MPEP 608.01 (n), Section III.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-11, 23-26, 28-34, 36-47 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US Patent 2002/0032612 A1).

With reference to claims 1 and 33, Williams teaches a computer-implemented method and system for facilitating shipment and return of a package containing items from a Sender to a Recipient (See Williams Abstract), the method comprising the steps of: electronically storing package data, for the package, and including item data, for the items in the package, in a database (See Williams Paragraphs 148-150, 375, Figures 27A and 40); electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism (See Williams Paragraphs 148-152, 375); electronically adding the shipment tracking data to the database (See Williams Paragraphs 148-152); electronically correlating the package data in the database with the shipment tracking data (See Williams Paragraphs 149, 455-472); and permitting an authorized user to query the database for facilitating the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package (See Williams Paragraphs 28, 30, 133, 136, 152 and 375-410).

With reference to claims 2 and 34, Williams teaches the step of electronically assigning the package to a specific combination of a shipper and shipping method based on the package data (See Williams Figures 12 and 38, Paragraphs 330-371).

With reference to claims 4-11 and 36-43, Williams teaches the steps wherein the package data includes at least the originating address and the destination address (See Williams Figure 27A), and the item data includes a description of the items in the package (See Williams Paragraph 150), said method further comprising the step of: using the package data to electronically calculate shipping charges and electronically generate invoices associated with the shipment (See Williams Paragraph 333); wherein the item data includes the description and value of each item (See Williams Paragraph 150); wherein the step of storing package data comprises transmitting package data via the Internet (See Williams Paragraphs 138, 139 and 142); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network including the Internet in response to the query parameters (See Williams Paragraphs 138, 139 and 142); further comprising the steps of: electronically adding returned item information to the database if items from the package are returned to the Sender (See Williams Paragraph 150); in the case of international shipments, electronically preparing duty and tax refund claims based on the returned item information and the corresponding item data; and electronically adding duty and tax refund information to the database (See Williams Paragraphs 187, 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters (See Williams Paragraphs 152

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and 153); wherein the computer network comprises the Internet (See Williams Paragraphs 142, 152 and 153).

With reference to claims 23-26, 28-30, 44-47 and 49-52, Williams teaches the steps and means of selecting a shipping assignment for the package based on the package data (See Williams Paragraphs 330-371); generating appropriate shipping documents for the package (See Williams Abstract and Paragraph 17) comprising package labels (See Williams Paragraph 258) and shipping manifests (See Williams Paragraphs 396 and 404); providing a Web site page for permitting the authorized user to query the database (See Williams Paragraphs 173, 174, 179-182); generating duty and tax refund claims based upon Receipt of returned item data (See Williams Paragraphs 497 and 533); adding return item information to said database if items from a package are returned to the Sender (See Williams Paragraph 639), and preparing duty and tax refund claims based on the returned item information (See Williams Paragraphs 497 and 533).

With reference to claims 31, 32 and 52, Williams teaches computer program product including one or more computer-readable instructions configured to cause one or more computer processors to perform the steps recited in claim 1 and a computer system including one or more hardware and/or software devices configured to perform the steps recited in claim 1 (See discussion of claims 1 and 33 above). A computer program product and a computer system including one or more hardware and/or software devices are inherent in the disclosure of Williams.

7. Claims 3, 27, 35 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US Patent 2002/0032612 A1) in view of Riggs et al (US Patent 2002/0065738 A1).

With reference to claims 3, 27, 35 and 48 Williams teaches a method and system of claims 1 and 33 respectively as discussed above.

Williams does not explicitly teach the steps of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker and generating appropriate customs forms.

Riggs teaches the steps of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker (See Riggs Paragraphs 88-91) and generating appropriate manifests and customs forms (See Riggs Paragraphs 55 and 88).

Both Williams and Riggs are concerned with providing transport logistics support for users in shipping goods. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Riggs to the invention of Williams. The combination of the disclosures taken as a whole, suggests that users would have benefited from the convenience of complying with customs regulations in one session using a user-friendly interface.

#### ***Response to Arguments***

8. With reference to Applicant's arguments that the applied references do not teach "method and system for facilitating shipment and return of a package containing items, wherein, advantageously, everything can be tied to the contents (i.e., items) of a package being shipped by correlating package data for the package, and including item data for the items in the package, with shipment tracking data for the package. Advantageously, returns can be handled on an item-

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by-item basis, rather than on a shipment-by-shipment basis, items are correlated to an accurate description thereof to facilitate customs clearance of each item," and each package, and each item in each package, can be tracked and the results made available over a network such as the Internet", and "prior art shipping companies normally treat individual packages as the important units, and are not concerned with the contents in terms of their shipping processes. The inventions recited in claims 1 and 33, on the other hand, care primarily about the package contents, and track each item in a given package throughout the shipping process and, if necessary, throughout a returns process" the Examiner respectfully disagrees. In paragraphs 455-472, Williams clearly discloses that every product in the package can be tracked item by item.

Applicant's other arguments with respect to claims 1- 11 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is ~~(571) 272-0345~~. *(703) 872 9306*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian

April 24, 2005

  
Jagdish N. Patel

Primary Examiner